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DEC 03 2007

OFFICE OF PETITIONS

In re Application of	:	
Alphonse Du Perron	:	DECISION ON THIRD RENEWED
Application No. 10/718,296	:	PETITION PURSUANT TO
Filed: November 21, 2003	:	37 C.F.R. § 1.181(A)
Title: INSTANTANEOUS EVACUATION	:	
TUBE	:	

This is a decision on the third renewed petition pursuant to 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment, filed on November 1, 2007. A duplicate of this petition was submitted on November 5, 2007.

The petition is **DENIED**¹.

The prior decisions that refused to withdraw the holding of abandonment pursuant to 37 C.F.R. § 1.181(a) have been reconsidered. Pursuant to the discussion below, the holding of abandonment will not be withdrawn.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed March 9, 2005, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on May 10, 2005. A notice of abandonment was mailed on September 23, 2005.

¹ This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP § 1002.02. No further reconsideration of this matter will be given.

An original petition was filed on October 25, 2005, and was dismissed via the mailing of a decision on June 5, 2006. Petitioner had asserted that the non-final Office action had not been received, and the decision on the original petition indicated that it appeared that Petitioner had provided the Office with an incorrect correspondence address. The decision set forth, in pertinent part:

The electronic file record has been reviewed, and the non-final Office action was returned to the Office as undeliverable on April 20, 2005.

It is noted that on September 17, 2004, a change of address was received from the applicant, containing this address:

6210 Boulevard St-Michel #2, MTL QC H2E-2Y9
H1Y2E7

The change of address was entered and made of record, accordingly. The missing communication was addressed to:

Alphonse Du Perron
6210 Boulevard St-Michel #2
MTL, QC H1Y 2E7
CANADA

With the present submission, Petitioner has included a Change of Correspondence request, which has been entered and made of record. The request indicates that the address should be changed to 6210 Boulevard St-Michel #2, MTL QC H2E 2Y9 (emphasis added). Curiously, the return address, which is listed on this same Change of Correspondence request, contains the zip code H1Y 2E7.

It appears that Petitioner is confused as to what his zip code is. Consequently, the Office mailed the non-final Office action to the improper address which was provided by Petitioner, and since this address was incorrect, the mailing was returned to the Office as undeliverable.

Accordingly, Petitioner's assertion that the Office action was not received is insufficient to justify withdrawing the holding of abandonment, as the failure to receive the Office action occurred due to Petitioner's error.

A renewed petition was filed on July 31, 2006, which was dismissed via the mailing of a decision on August 8, 2007, as the submission had not been executed.

A second renewed petition was filed on September 4, 2007, and was dismissed via the mailing of a decision on September 21, 2007. The decision set forth, in pertinent part:

With this second renewed petition, it does not appear that Petitioner has submitted any arguments, evidence, or commentary addressing the merits of the dismissal of the original petition.

RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. § 1.134 sets forth, *in toto*:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
- (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

MPEP 711.03(c) states, *in pertinent part*:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three

month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ2d 26, 29-30 (CCPA 1964); Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

ANALYSIS

With the decision on the original petition, it was set forth that the Office properly mailed the non-final Office action of March 9, 2005, to the address that appears in the Change of Correspondence Address request that was submitted by Applicant on September 17, 2004. However, this request contained an incorrect zip code. It follows that the communication was not received by Applicant, due to the fact that Applicant directed the Office to mail all future correspondence to an incorrect address.

With this second renewed petition, Petitioner has not addressed the merits of why this incorrect zip code was placed on the Change of Correspondence Address request, or why the abandonment, which occurred as a direct consequence of Applicant's filing error, should be withdrawn. With this second renewed petition, Petitioner has merely set forth that the failure to receive the non-final Office action is

surprising because I did receive before some mail from the Office, for example "The confirmation of my Foreign Application" mailed by the Office on September 29, 2004...it does mean that you had the right address in your file.

With this second renewed petition, the fact remains that the reason that Applicant did not receive the Office action is because he placed the wrong zip code on the Change of Correspondence Address request. As such, he informed the Office

that all future correspondence should be sent to an incorrect address.

Conclusion

The prior decisions, which refused to withdraw the holding of abandonment, have been reconsidered. For the above stated reasons, the holding of abandonment will not be withdrawn.

A review of the petitions that Petitioner has submitted suggests that Petitioner is unfamiliar with petitions procedure. While an inventor may prepare and submit petitions, lack of skill in this field usually acts as a liability. Petitioner is advised to secure the services of a registered patent attorney or agent to prepare any subsequent petition(s). The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

Petitioner may wish to consider filing a petition under 37 C.F.R. §§ 1.137(a) and/or (b). Petitioner may download information about these petitions here:

http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c. No assurance can be made that any remedy will be forthcoming.

The general phone number for the Office of Petitions that should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.



Charles Pearson
Director
Office of Petitions
United States Patent and Trademark Office